

REMARKS

This Preliminary Amendment, filed in conjunction with a Request for Continued Examination (“RCE”), represents a full and timely response to the Final Office Action mailed August 8, 2006. The filing of this RCE and Amendment is permissible under 37 C.F.R. § 1.114. *See* M.P.E.P. § 706.07(h).

The present Amendment amends the Specification, as well as claims 1-4, 6, 12, 13, and 15-18, and cancels claims 5, 11, 14, 19, and 21 in order to further clarify a portion of the scope sought to be patented, and otherwise disputes certain findings of fact made in connection with the rejection of the claims. Support for these amendments can be found variously throughout the specification, including, for example, original claim 14. *No new matter has been added.*

Request for Rejoinder

Applicant hereby formally requests rejoinder of the subject matter of withdrawn claims 1-4 and 12 be rejoined under *In re Ochiai* upon allowance of the elected product claims.

The MPEP states “if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must depend from or otherwise require all the limitations of an allowable product claim for that process invention to be rejoined” (*see MPEP § 821.04(b)*). Claims 1-4 and 12 as amended contain all the limitations of product claim 13, and are therefore allowable upon allowance of claim 13

Additionally, Applicant formally requests rejoinder of the subject matter of withdrawn claim 15 upon allowance of claim 13, which is drawn, *inter alia*, to a composition containing a polyol compound as recited in claim 15.

Specification

The specification has been reviewed in light of the Examiner's comments, and has been amended in order to correct minor matters of form and syntax, and to clarify portions of the specification as filed. The changes are included in this amendment along with markings showing the changes made.

The chemical formula found on page 13 line 14 has been amended to present the original formula as filed. Tables 1-3 have also been amended to in light of the Examiner's comments to clarify portions of the Tables based on the disclosure in the specification. Entry of these changes, involving minor matters not involving new matter, is respectfully solicited.

Claim Rejections- 35 U.S.C. § 112

In the Action, claims 6, 9-10, 13-14, and 16-21 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Additionally, claims 6, 9-10, 13-14, and 16-21 were rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. The rejections were based on subject matter contained in on page 13, lines 10-16, in Tables 1-3, in the incorporation by reference on page 56, and in the claims themselves. Applicant respectfully traverses these rejections.

The incorporation by reference of the subject matter of Japanese Application No. 2002-344540 is removed from page 56 of the Specification. Accordingly, withdrawal of the rejection based on the incorporation by reference on page 56 is courteously solicited (*see paragraph 3 of the Office Action*).

By this amendment, the subject matter of claim 14 has been incorporated into claim 13. Accordingly, withdrawal of the rejection of claims 6 and 13 based on the amino-epoxy resin is respectfully requested (*see paragraph 5 of the Office Action*).

The chemical structure of the composition shown on page 13, lines 10-16 has been amended to show the chemical structure of the composition as originally filed. Accordingly, withdrawal of this rejection is respectfully requested (*see paragraph 6(a) of the Office Action*).

Tables 1 and 2 have been amended to indicate that the values shown in parentheses are “parts by weight in terms of solid content.” While the values can also be correctly expressed as “parts by weight in terms of resin content” (*see, e.g., Preparation Example 2*), the expression of the values as “parts by weight in terms of solid content” maintains consistency in the language and terminology already employed in Tables 1 and 2. Support for the language “parts by weight in terms of solid content” finds support in original Tables 1 and 2, as well as Preparation Examples 1-22 of the Specification.

One can easily determine the parts by weight in terms of solid content from the parts by weight displayed in Tables 1 and 2 and the percent solid content shown for the compositions in the Tables. For example, Base Resin No. 1 has a solid content of 80% by weight, and 87.5 parts by weight of Base Resin No. 1 is used in Preparation Example 11 (*see Table 1, Preparation Example 1, and Preparation Example 11*). Accordingly, $(80\% \text{ solid content}) * (87.5 \text{ parts by weight}) = 70 \text{ parts by weight in terms of solid content}$ (*see Table 1*).

In regards to Table 2, Example 21 includes an Epoxy quaternary ammonium type dispersing resin having a solid content of 60% by weight, which is equal to 3.5 parts by weight in terms of solid content (*see Table 2 and Preparation Example 21 of the Specification*).

Accordingly, in view of the above changes to clarify Tables 1 and 2, withdrawal of the rejection of these tables is respectfully requested (*see paragraph 6(b) of the Office Action*).

In Table 1, the acronyms “MDI-PG” and “IPDI-OX” have been removed. Additionally, MDI and propylene glycol, as well as Isophorone diisocyanate and methyl ethyl ketoxamime, have been added to describe the primary components present in Curing Agents No. 2 and 3 (*see Preparation Examples 9 and 10 in the Specification at pages 46 and 47*). Accordingly, withdrawal of this rejection is courteously solicited (*see paragraph 6(c) of the Office Action*).

Table 3 has been amended to include the symbol “***” instead of “*” in referencing the parts by weight, thereby eliminating the possibility of any confusion. Accordingly, withdrawal of this rejection is courteously solicited (*see paragraph 6(d) of the Office Action*).

Claim 13 is presented in clean form, thereby eliminating any confusion due to the strikethrough present in the previous amendment. Accordingly, withdrawal of this rejection is respectfully requested (*see paragraph 8 of the Office Action*).

Objections to the Specification under 35 U.S.C. § 132(a)

The Specification was objected to under 35 U.S.C. § 132(a) for allegedly presenting new matter. In light of the amendments and the arguments provided above, *supra*, Applicant respectfully requests withdrawal of these objections.

Claim Objections

In the Action, claim 19 was objected to under 37 C.F.R. § 1.75(c) for failing to further limit the subject matter of claim 14. With this amendment, claim 19 is canceled, thereby obviating this rejection.

CONCLUSION

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. KPC-0309 from which the undersigned is authorized to draw.

Dated: December 28, 2006

Respectfully submitted,

By 

Christopher J. Wickstrom

Registration No.: 57,199

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750